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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,656	02/14/2001	Harald Vater	JEK/VATER	7577

7590 10/26/2006

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EXAMINER

DAVIS, ZACHARY A

ART UNIT PAPER NUMBER

2137

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/700,656

Applicant(s)

VATER ET AL.

Examiner

Zachary A. Davis

Art Unit

2137

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the rejection of Claim 42 under 35 U.S.C. 112, second paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 26-33 and 42.
Claim(s) withdrawn from consideration: 1-25, 34-41 and 43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:
Applicant's arguments are not persuasive.

Regarding the requirement for restriction, in response to Applicant's arguments, the Examiner notes that MPEP 1850, IV. (as cited by Applicant at page 10 of the present response) is only directed to the performance of a search on the invention(s) claimed in a PCT application before the INTERNATIONAL SEARCHING AUTHORITY. That portion of the MPEP is NOT applicable to national stage applications. The Examiner notes that 35 U.S.C. 372(b)(2) sets forth that unity of invention is examined under 35 U.S.C. 121 within the scope of the treaty itself and the regulations; notably, 37 CFR 1.499 states that Applicant may be required to elect an invention. Although PCT rules provide for payment of additional fees for the search of additional inventions, there is nothing in the PCT rules or US statutes or regulations that suggest that an Examiner may require additional fees for examination of more than one group. Once an invention has been elected, claims drawn to the other invention(s) are withdrawn from further consideration. See 37 CFR 1.142(b).

Further regarding the requirement for restriction, Applicant argues that, under the unity of invention rules, restriction between an apparatus and a method of use of that apparatus is improper. The Examiner does not disagree with this statement. However, the Examiner does respectfully disagree with the assertion that method claims 26-33 and 42 are directed to methods of use of the apparatus (i.e. data carrier) of Claims 1-21, noting that nowhere in method claims 26-33 and 42 is there any recitation whatsoever of using a data carrier such as the one claimed in Claims 1-21. Although, as Applicant asserts, and as set forth in MPEP 1893(d), the phrase "specially adapted" does not require that the product be exclusively for use with the process, the process must actually use the product to be considered a process of use of the product so as to define a combination of categories having unity of invention under 37 CFR 1.475(b)(2). The Examiner further notes that in the election response received 16 November 2005, Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement and therefore the election was treated as being made without traverse, as noted in the previous two Office actions.

Regarding the rejections under 35 U.S.C. 102(e) and 103(a), Applicant argues that Jakobsson (US Patent 6049613) does not disclose compensating for combination of the original input data with auxiliary data, where the compensation is performed using the result of applying a function to the used auxiliary data. However, the Examiner believes that Jakobsson does, in fact, disclose compensating for the combination; specifically, in response to Applicant's assertion that there is no compensation for the re-encryption operation, the Examiner notes that Jakobsson explicitly states that the encryption provided by the first blinding section (i.e. the re-encryptoin) is decrypted (see column 10, lines 5-6, as cited in the previous Office action).

Applicant also argues that "since the data to combined [sic] by Jakobsson with the input data is random, Jakobsson cannot pre-store the auxiliary data" (page 12 of the present response). However, the Examiner notes that this conclusion does not appear logically or necessarily to follow from the use of random data, as there is nothing to prevent random data from being pre-generated and pre-stored, or to keep pseudo-random data from being pre-computed and pre-stored.